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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,840	12/29/2003	William T. Graushar	077047-9410-02	6450

23409 7590 04/21/2005

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EXAMINER	
MACKEY, PATRICK HEWEY	

ART UNIT	PAPER NUMBER
3651	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/747,840	GRAUSHAR ET AL.	
	Examiner	Art Unit	
	Patrick H. Mackey	3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *5,10 and 15-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-9, 11-14, 21-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 6, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill et al. (US 5,388,815). Hill discloses a method that includes writing electronic information to an optical disk (36) on a binding line (20), reading information from an electronic disk (36) on a binding line (57), and associating the disk with a product printed (26) with personalized indicia.

3. Claims 11, 13, 14, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill et al. (US 6,431,453). Hill discloses a method that includes reading electronic information from an optical disk on a binding line (76), and associating the optical disk with a printed product (104).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3, 6-7, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace et al. in view of Hill et al. (US 5,388,815). Pace discloses a method for associating a CD with a printed product, but it does not disclose writing electronic information on a binding line. However, Hill discloses writing electronic information on a binding line for the purpose of delivering owner specific electronic media to an account owner. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Pace by writing electronic information on a binding line for the purpose of delivering owner specific electronic media to an account owner.

6. Claims 4 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace et al. in view of Hill et al. (US 5,388,815) as applied to claim 6 above, and further in view of Harris, Jr. et al. Pace and Hill together disclose all the limitations of the claims, but it doesn't disclose printing personalized indicia in response to what was read from the optical disk after associating. However, Harris, Jr. discloses a similar method that includes printing personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to print personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. (US 6,431,453) in view of Harris, Jr. et al. Hill discloses all the limitations of the claims, but it doesn't disclose printing personalized indicia in response to what was read from the optical disk after associating. However, Harris, Jr. discloses a similar method that includes printing

personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to print personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product.

Response to Arguments

8. Applicant's arguments filed 1/31/05 have been fully considered but they are not persuasive.

9. The applicant states that Hill815 does not disclose a binding line. In response, at least see col. 11, line 65 – col. 12, line 10.

10. The applicant states that the examiner failed to identify the optical disk in the reference. In response, see at least item 36.

11. The applicant states that in Hill, the carrier form is not printed based on what was written to the optical disk as required by claim 3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "based on") are not recited in the rejected claim 3. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. The applicant states that Hill does not disclose delivering a plurality of printed products to the binding line based upon information written to or read from the optical disk. In response, see at least col. 12, lines 50-67.

13. The applicant states that the examiner indicated that a pre-encoded smart card source 76 of Hill453 is a binding line. The examiner disagrees. The pertinent rejection states Hill discloses a method that includes reading electronic information from an optical disk on a binding line (76), and associating the optical disk with a printed product (104).

14. The applicant states that the examiner has failed to identify the optical disk in the Hill453 reference. In response, see at least item 30.

15. The applicant states that Hill453 does not disclose delivering a plurality of printed products to the binding line based upon information read from the optical disk. In response, see at least col. 4, line 62 – col. 5, line 31.

16. Regarding the rejections under 35 U.S.C. § 103, the applicant states that there is no motivation to combine Pace with Hill815. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Pace by writing electronic information on a binding line for the purpose of delivering owner specific electronic media to an account owner. See at least Hill815, col. 7, lines 4-20.

17. The applicant states that there is no motivation to further combine the teachings of Harris with either Pace and Hill815 or with Hill453. In this case, it would have been obvious for a

person of ordinary skill in the art at the time of the applicant's invention to print personalized indicia in response to read electronic information after associating, as disclosed by Harris, for the purpose of printing proper address labels on a printed product. See at least the Abstract.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (571) 272-6916. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick H. Mackey
Primary Examiner
Art Unit 3651

April 15, 2005